R E M A R K S

Reconsideration of the present application in view of the amendments and following remarks is respectfully requested. The Specification and Figures 3, 7, 10 and 11 have been amended to correct minor informalities and to address other issues raised by the Examiner. Claims 1 through 20 have been cancelled without prejudice. Claims 21 through 47 have been added. Twenty-seven claims are pending in the application: Claims 21 through 47.

By way of this amendment, Applicant has made a diligent effort to place the claims in condition for allowance. However, should there remain any outstanding issues that require adverse action, it is respectfully requested that Examiner telephone the undersigned at (805) 781-2865 so that such issues may be resolved as expeditiously as possible.

Amendments to Specification

Support for the amendment to the Specification for the paragraph beginning at page 22, line 30 can be found in originally filed Figure 4.

New Claims

New claims 21 through 47 have been added. Support for these new claims can be found throughout the originally filed specification, drawings and originally filed claims.

Specifically, support for claims 21-24 can be found at Pages 16-17 and in Fig. 2 of the originally filed application.

Support for claims 25-26 can be found at pages 18-20 of the originally filed application.

Support for claim 27 can be found at pages 1 and 3 of the originally filed application.

Support for claims 28-34 can be found at pages 16-18 of the originally filed application.

Support for claim 35 can be found at page 20 of the originally filed application.

Support for claim 36 can be found at page 16-20 of the originally filed application.

Support for claims 37-39 can be found at pages 16-18 of the originally filed application.

Support for claim 40 can be found at page 20 of the originally filed application.

Support for claims 41-47 can be found at pages 18-20 of the originally filed application.

35 U.S.C. §102

1. Claims 1-7, 9-15 and 17-20 stand rejected under 35 U.S.C. 102(a) as being anticipated by U.S. Patent No. 6,263,501 (*Schein et al.*).

Claims 1-20 have been cancelled, thus the rejection will be addressed in view of newly submitted claims 21-47.

Schein et al. disclose a system in which a user can interact with a program guide (database) and is able to find additional information located in the database which relates to a category choice (Column 14, line 56 through Column 15, line 25). When a user selects the category choice, the program guide (database) is searched for other information relating to their choice. Once the user sees the list of broadcast times relating to their choice the user can select any of the available

broadcast times for recording or watching (Column 15, lines 25 through 30).

In contrast, newly submitted independent claim 21 recites "searching a network for information relating to the keyword." As described in the specification at page 22, lines 19-20, the network can include performing a search of the World Wide Web. Applicants are not performing a search of additional program guide data rather are performing a search of a network for information related to the keyword. Applicants' claimed invention includes "searching a network for information relating to the keyword" not searching a program guide for related programming data as described in *Schein et al.* As is such, *Schein et al.* do not disclose every element of newly submitted claim 21.

Further regarding independent claim 21, *Schein et al.* disclose transmitting the electronic program guide over a number of different media, including a telephone line and a satellite link. In contrast, Applicants claim "receiving a keyword embedded in the video image." As describe in the specification at page 20, lines 3-6, the keyword is added to the video stream. *Schein et al.* do not embed a keyword in the video image, rather they transmit a program guide in a separate data stream. Thus, Applicants submit claim 21 is in condition for allowance and the rejection is overcome. Additionally, Applicants submit claims 22 through 30 are in condition for allowance at least because of their dependency upon allowable claim 21.

New independent claim 31 recites the steps of "selecting at least a portion of the video image" and "displaying a keyword associated with the portion of the video image in response to the selecting of the portion of the video image."

Schein et al. disclose that a user can indicate to the electronic program guide what information they would like to view on the television (Column 14, lines 60 through 66). The electronic program guide then lists a selection of choices to the user (Column 14, lines 66-67). The user then selects from the presented choices, and the electronic program guide contacts and communicates with the database of available information for more detailed information relating to the users choice (Column 15, lines 7-10). Thus, the user selects a choice after indicating to the electronic program guide what information they would like to view.

In contrast, Applicants' independent claim 31 recites the steps of "selecting at least a portion of the video image" and "displaying a keyword associated with the portion of the video image in response to the selecting of the portion of the video image." For example, as described on page 17, lines 16-20, Applicants' invention would allow for the use of an on-screen pointing device to select coordinates in a video image. A keyword associated with those coordinates would then be displayed. As an example if a pair of shoes was shown in the video image and a user points the on-screen pointing device at the shoes, the word "Nike" may appear. Applicants submit that *Schein et al.* do not ever show or suggest the display of "a keyword associated with the portion of the video image in response to the selecting of the portion of the video image," such as claim by Applicants. Additionally, Applicants submit *Schein et al.* do not ever disclose "selecting a portion of a video image" such as claimed by Applicants. Thus, Applicants submit claim 31 is in condition for allowance and the rejection is overcome. Additionally, Applicants submit claims 32 through

36 are in condition for allowance at least because of their dependency upon allowable claim 31.

New independent claim 37 recites the steps of "selecting at least a portion of the video image" and "sending over a network a keyword associated with the portion of the video image in response to the selecting of the portion of the video image." As described above with reference to claim 31, *Schein et al.* do not disclose "selecting at least a portion of a video image" such as claimed by Applicants. Thus, Applicants submit claim 37 is in condition for allowance and the rejection is overcome. Additionally, Applicants submit claims 38 through 44 are in condition for allowance at least because of their dependency upon allowable claim 37.

New independent claim 45 recites the steps of "receiving a code relating to the keyword" and "receiving information relating to the keyword and the code." *Schein et al.* do not disclose these steps. Specifically, *Schein et al.* do not ever disclose or suggest the step of "receiving a code relating to the keyword." Additionally, *Schein et al.* do not disclose the step receiving information relating to both a keyword and a code. Thus, Applicants submit claim 45 is in condition for allowance. Additionally, Applicants submit claims 46 and 47 are in condition for allowance at least because of their dependency upon allowable claim 45.

Regarding dependent claims 25, 36 and 42, Applicants recite "wherein the received information is based upon a user profile." The Examiner asserts that *Schein et al.* disclose this element. *Schein et al.* disclose customizing the display of the television schedule guide to an individual viewer or a group of viewers (Column 15, lines 40-45). Additionally, different

programs can be selected based upon an individual viewer. However, *Schein et al.* do not disclose "receiving information based upon the user profile." Thus, Applicants assert that claims 25, 36 and 42 are in condition for allowance.

35 U.S.C. §103

2. Claims 8 and 9 stand rejected under 35 U.S.C. 103(a) as being unpatentable over by U.S. Patent No. 6,263,501 (*Schein et al.*) in view of the "Advanced Television Enhancement Forum Specification."

The rejection states that claims 8 and 9 stand rejected under 35 U.S.C. 103(a), however, Applicants believe this is in error and that the Examiner intended to reject claims 8 and 16, as these claims both recite "wherein the content utilizes the Advanced Television Enhancement Forum Content Specifications." Claims 8 and 16 have been cancelled without prejudice, thus the rejection is overcome.

Drawings

3. The drawing were objected to under 37 C.F.R. 1.84(p)(5) because of numerous errors that were indicated by the Examiner in paragraphs 1 through 3 of the Office Action.

Figures 3, 7, 10 and 11 have been amended in order to comply with the objections noted by the Examiner and to correct other minor informalities. Applicants have enclosed a clean version of the figures along with marked up versions to show the changes made.

Information Disclosure Statement

4. The Examiner has indicated the information disclosure statement filed on 9/19/2001 failed to comply with 37 C.F.R. 1.98(a)(2), which requires legible copies of each reference.
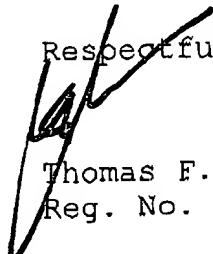
Applicants have included a copy of the Information Disclosure Statement and PTO-1449 form originally filed on 9/19/2001 along with a copy of a return receipt postcard indicating its receipt by the U.S. Patent and Trademark Office (USPTO). The office action indicates that the office does not have copies of the references previously provided by Applicants, and received by the USPTO as indicated by the PTO-1449 form and return receipt postcard previously submitted. It appears the references were not considered because they could not be located by the Examiner.

In order to expedite the consideration of these references, Applicants have attached additional copies of these references for full consideration by the Examiner. As Applicants already previously submitted these references and these references were received by the USPTO, Applicants believe that further fees and petitions are not required for these references to be fully considered. As such, Applicants respectfully requests full consideration of the references cited on the PTO-1449 form.

CONCLUSION

In view of the above, Applicants submit that the pending claims are in condition for allowance, and prompt and favorable action is earnestly solicited. Applicants have made a diligent effort to place the claims in condition for allowance. However, should there remain any outstanding issues that require adverse action, it si respectfully requested that the Examiner telephone Thomas F. Lebens at (805) 781-2865 so that such issues may be resolved as expeditiously as possible.

Respectfully submitted,

Thomas F. Lebens
Reg. No. 38,221

Dated: February 28, 2003

Address all correspondence to:

FITCH, EVEN, TABIN & FLANNERY
Thomas F. Lebens
120 South LaSalle Street, Ste. 1600
Chicago, IL 60603
(805) 781-2865

<u>VERSION WITH MARKINGS TO SHOW CHANGES MADE</u>

<u>In the specification:</u>

The following shows the changes made to the paragraph beginning at page 21, line 24:

"Figure 3 is a block diagram of a system that operates in accordance with an embodiment of the present invention. A variety of systems may be used. For example, a multimedia computer, such as the Sony PC manufactured by Sony Corporation may be utilized. The system 300 typically includes a central processing unit (CPU) 330, memory 335, input/output circuitry 325, as well as other circuitry and components that are will known to those skilled in the art. The system 300 outputs information to a display 320 and, may also provide audio through speakers [326]. The information may be received through receiver 305. Receiver 305 in one embodiment is a satellite receiver for receiving satellite transmissions of broadcasts and programming information through antenna 306. Using the programming information received through receiver 305, the system 300 can generate an electronic program guide (EPG) on the display 320. As will be described below, the EPG can be modified or filtered according to the searching performed by the user using the search engine described herein."

The following shows the changes made to the paragraph beginning at page 22, line 30:

"Referring to Figure 4, as user, using a search engine window 402 can establish the topics that form elements of a filter 404 that is input to a search engine 406. The search engine 406 interacts with the different information resources,

e.g., internet 412, cable broadcast 410 and satellite broadcast 408, to generate a result set 414 of information. This set 414 is applied to the EPG 416 to modify the EPG 416 to display or highlight those programs that meet the filter requirements. These results may then be displayed in the display 422. The result set 414 is also sent to the browser window 418."

The following shows the changes made to the paragraph beginning at page 34, line 17:

"Once the viewer has completed marking a selection of broadcast events, AT 1184 is stored into a network access device 1121, whether in the resident memory inside network access device 1121 coupled to a TV tuner 1134, or in an alternative embodiment, in the resident memory of a personal computing device [1120]. When the viewer is ready to browse the websites associated with the selected broadcast events, either network access device [21] 1121, or the personal computing device [1120], transmits activity table 1184 comprising the AR entries and also viewer identifying data, such as a particular demographic data, for example, the postal code of the viewer's location, via on-line service 1160 to a central database 1140. Database 1140 comprises information compiled from various sources, such as TV advertisements schedules 1150 associated with various TV shows, TV show schedules 1152, TV advertisers' websites 1162 and other websites 1164 topically related to broadcast content [1164] 1130. AT 1184 is then used to determine which data in the database 1140 should be retrieved and presented to the viewer. For example, one of the AR entries in the AT might be (Sep. 1, 1999-19:30:32-CH7), indicating the date, time, and channel selected. This data, along with the viewer's regional information, is then compared to

the TV advertisement schedule 1150 in database 1140 to determine the TV advertisements broadcast at the time of activating select button 1115. Database 1140 then generates a custom list of data for the user which indicates bookmarks associated with the broadcast event. For example, this list of data could take the form of, but not limited to, a World Wide Web (WWW) page on the Internet. The viewer could then view these with a generic WWW browser."

The following shows the changes made to the paragraph beginning at page 38, line 3:

"Figure 12 illustrates an automated custom program scheduling method using TV event marking system 1100 of Figure 11. Automated custom program schedule method 1200 accesses on-line broadcast event listings in database 1140 to allow viewer to bookmark in advance selected scheduled broadcast events or websites for automated TV viewing. Automated custom scheduling method 1200 comprises a first operation 1202 of accessing database 1140 via network accessing device [1120] 1121 to view scheduled broadcast events. Then, in operating 1204, viewer selects the set of broadcast events to be viewed. Once selection is completed, a corresponding custom schedule identifying selected the date, time and channel of all selected events is generated in operation 1206[7]. Then, in operation 1208, the custom schedule is downloaded to custom command table comprising a time-based command sequence is then executed by the CPU in the network access device 1121 in operation 1210 to instruct TV tuner 1134 to automatically change channels in a time sequence provided in the custom command table. It is envisioned that remote controls comprises bi-directional I/O port and thus can be

remotely programmed by personal computer system or network access device."